

Appl. No. 10/614,500
 Amdt. dated 08/01/2005
 Reply to Office action of 06/01/2005

REMARKS / ARGUMENTS

For the convenience of the Examiner and clarity of purpose, Applicant has reprinted the substance of the Office Action in *10-point bolded and italicized font*. Applicant's arguments immediately follow in regular font.

Claims 12-16, 18-21, 23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Finley 5,676,208. Finley discloses a well treatment tool. (See figures 1-3). Return port 134 is provided in the wall of the tool to establish a fluid flow path between an exterior and an interior portion of the well treatment tool. Sleeve 126 is considered a return port cover. The sleeve 126 is coupled to the wall proximate the return port 134. Figure 3A shows the return port closed by sleeve 126 and figure 3B shows the port opened. Engagement means 152 on sleeve 126 is adapted to engage the engagement surface of a shifting tool (not shown). The shifting tool is considered to be disposed downhole and independent from the well treatment tool. (See col. 10, lines 11-25).

Applicant respectfully traverses this rejection. Finley does indeed disclose a well treatment tool, such as service tool string 42, shown inside of a downhole member, such as tubular liner assembly 20, in Figures 1a and 1b. Figures 4a and 4b similarly show service tool string 188 shown inside of tubular liner assembly 170. In contrast, Figures 2a, 2b, 3a and 3b do *not* show a service tool of any type. These figures only show components of the downhole member, i.e., tubular liner assembly 20, into which a service tool, such as service tool string 42 may be placed. Or, as described by Finley:

Turning now to *FIGS. 3A and 3B*, another *gravel packing apparatus 120* embodying principles of the present invention is representatively illustrated, which may be utilized for the apparatus 30 in the method 10 shown in FIGS. 1A and 1B. The apparatus 120 includes tubular upper housing 122, tubular lower housing 124, tubular sleeve 126, and tubular screen 128. *The upper housing 122 has threaded upper end connection 130, and the lower housing 124 has threaded lower end connection 132, for sealing attachment into the liner assembly 20 representatively illustrated in FIGS. 1A and 1B.* Thus, upper end

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connection 130 is threadedly and sealingly attached to intermediate portion 28, and lower end connection 132 is threadedly and sealingly attached to the lower portion 36 when apparatus 120 is used for apparatus 30 in method 10.

Finley at col. 9, lines 17-31 (emphasis added).

To the extent the Office considers sleeve 126 in Figures 3a and 3b to disclose a return port cover as recited in claim 12, the return ports of Finley (reference number 134) do not “establish a fluid flow path between an exterior portion and an interior portion of the well treatment *tool*.” No tool is shown in Figure 3a or 3b. Indeed, Finley plainly describes that a separate tool is contemplated for use with the apparatus shown in Figures 3a and 3b:

Sleeve 126 includes an internal shifting profile 152 formed thereon. Shifting profile 152 permits engagement therewith by *a conventional wireline or slickline shifting tool (not shown)* for displacing sleeve 126 relative to the upper and lower housings 122 and 124 before or after the shear pins 150 have been sheared by the predetermined differential pressure.

Finley at col. 10, lines 12 – 15 (emphasis added).

Further, Applicant has amended claim 12 to make plain that the return port cover is coupled to the “*tool wall*,” which structure is not disclosed or taught by Finley. This amendment makes explicit that which was inherent and, thus, does not narrow the scope of claim 12.

Lastly, Applicant has amended claim 12 to make plain that the return port cover on the *tool* is adapted to engage “an associated engagement surface disposed downhole *on a member that is not the tool* for actuation of the return port cover when the surfaces engage” (emphasis added). Again, this amendment makes explicit that which Applicant considered inherent in claim 12 and, thus, does not narrow the scope of claim 12. See original claim 12. Applicant has also canceled claim 16 to reinforce these arguments.

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In summary, claim 12 requires that the return port and return cover be on the *tool* and that an associated engagement surface (which actuates the return port cover) is disposed on a downhole member that is not the tool. Figures 2 and 3 of Finley do not even show a tool and, thus, cannot disclose or teach a return port cover on a tool.

Figures 1 and 4 of Finley are the only arguable disclosure of a return port (ports 226) and return port cover (valve portion 204) in a well treatment tool (service tool string 188). However, Finley discloses that the valve portion 204 is actuated by differential pressure (column 13, lines 1-16). Finley contains no disclosure or teaching that the valve portion 204 is movable by mechanical engagement with a downhole member surface – only by differential pressure.

Thus, when the Finley “return port cover” is on the downhole member (Figures 2 and 3), Finley uses a tool to open and close the cover. When the Finley “cover” is on the tool (Figures 1 and 4), Finley use hydraulic pressure to open or close the cover. What Finley does not disclose or teach is using an engagement surface on the downhole member to open or close a “return port cover” on a tool. Applicant respectfully submits that claim 12 is patentably distinct from Finley. Reconsideration of this rejection is respectfully requested.

As to claim 13, the first position is used during circulation. As to claim 14, the second position is used during reversing to establish a second flow path distinct from the flow path when sleeve 126 is in the position of figure 3A. As to claims 15 and 21, the tool includes a cross-over 52. As to claim 16, the shifting tool is a downhole member. As to claim 18, the shifting tool operates the sleeve 126 independent of downhole conditions. As to claim 19, the entire assembly is run on a work string and the tool string is attached to the work string.

Claims 13 through 19 depend from independent claim 12. Applicant contends that claim

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12 as presented herein is patentable and, therefore, so to are claims 13 through 19. No amendments have been made to claims 13 through 19 in response to this rejection.

As to claim 20, packer 162 divides the annulus into an upper annulus above packer 162 and a lower annulus below the packer. Return port 134 facilitates communication between the upper and lower annulus when sleeve 126 is in the open condition. The downhole shifting tool engages the engagement means 152 of sleeve 126 for opening and closing ports 134 independent of a well treatment pressure.

Without acceding to the Offices characterization of what Finley discloses and reserving Applicant's right to later challenge that characterization, Applicant has chosen to amend claim 20 to require that the "means for at least partially opening and closing" "biases the return port to the at least partially closed position." As discussed in Applicant's 04/12/2005 Amendment with respect to claims 7 and 22, Finley does not disclose or teach that it is desirable to bias his sleeve. Claim 22 has been canceled in favor of this amendment.

Applicant respectfully submits that claim 20 is patentably distinct from Finley. Reconsideration of this rejection is respectfully requested.

As to claim 23, profile 152 engages a profile on the shifting tool. As to claim 25, the shifting tool is raised and lowered to operate the sleeve. As to claim 26, the shifting tool carries an engagement surface.

Claims 23, 25 and 26 depend from independent claim 20. Applicant contends that claim 20 as presented herein is patentable and, therefore, so to are claims 23, 25 and 26. No amendments have been made to claims 23, 25 and 26 in response to this rejection.

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Claims 17, 22 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant thanks the Examiner for his consideration of these claims. At the present time Applicant has chosen not to represent these claims in independent form in favor of the arguments and amendments made herein.

Claims 1-11 and 27-31 are allowed.

Applicant thanks the Examiner for allowing these claims.

Applicant's arguments filed 4/14/05 have been fully considered but they are not persuasive. Applicants' arguments with respect to claim 1, 22 and 27 are concurred with and these claims are indicated as containing allowable subject matter.

Applicant thanks the Examiner for allowing these claims.

Applicant does not argue the dependent claims independently; but only argues independent claims 12 and 20. Applicant argues with respect to claim 12, that only figure 4 is the only disclosure of return ports and return port cover in a well treatment tool: This is not concurred with. Figure 3 clearly be considered a return port 134 and sleeve 126 a return port cover in a well treatment tool.

As discussed above, Applicant contends that the Office is mistaken in equating the structure disclosed in Figures 2 and 3 of Finley as a "well treatment tool." Finley clearly and plainly states that the service tool is not shown in Figures 2 and 3.

With respect to claim 20, applicant argues that the limitation that the return port facilitates communication between an upper and a lower annulus and that the limitation means for at least partially opening and closing independent of a well treatment pressure are not taught by Finley. Clearly,

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when considering figure 3, sleeve 126 can be shifted from a closed to an open condition by a means independent of a well treatment pressure (see col. 10, lines 11-25). With respect to the limitation concerning facilitating communication between the upper and lower annulus. Clearly, when sleeve 126 is shifted to the open position, ports 34 facilitate communication between the upper and lower annulus.

For the reasons discussed above, Finely does not show a return port or cover in a well treatment tool in Figures 2 or 3.

Other Amendments to the Claims

Any amendment made to a claim that is not discussed above in direct response to a rejection or objection, was not made for reasons related to patentability.

Conclusion

The above presented arguments and amendments are thought to present this case in better condition for allowance. Applicant earnestly solicits favorable treatment and entry of this amendment. No fee is thought due for this paper, but if the undersigned is incorrect, the Commissioner is hereby authorized to charge to deposit account 12-1322 (020569-02500) the fees necessary to make this paper timely and effective.

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Applicant thanks the Examiner for his consideration and effort on this matter and submits that this application is now in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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